

## **REMARKS/ARGUMENTS**

Claims 1, 2, 5, and 7-11 are pending in the application and stand rejected. Claims 1, 2, 5, 8, 9 and 10 have been amended.

### **I. Claim Objections**

The Office has noted various objections to the claims along with suggested amendments to overcome such objections. Consequently, those claims have been amended to incorporate the suggestions of the Office.

### **II. Rejections Based on 35 U.S.C. § 102(b)**

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as being anticipated by Waldock (US 5,484,447). Those rejections are respectfully traversed.

Waldock is a caliper device for stretching eye tissue for the purpose of the insertion of a lens during ophthalmic surgery. It has no application whatsoever to the field of orthopedics or knee arthroplasty. Waldock, as illustrated in Figures 1-8A, comprises a pair of hinged members (10, 12) which are used to separate or spread eye tissue at the tips (34, 36). Pivotal movement of the members is accomplished by an adjustment mechanism (20) in the form of a rotatable knob (30) which draws the members together or spreads them apart, resulting in opening or closing of the tips. An alternative embodiment of Waldock in Figure 9 includes a different adjusting mechanism wherein the caliper has a spring (54) which biases the device to a closed position, and knob (30) is used to turn against the spring tension to open the tips.

Importantly, Waldock lacks a number of key features of claim 1, each of which are explained below:

(1) The preamble of claim 1 requires that the present invention be a “dynamic spacer”, although there is nothing dynamic about the Waldock device. Waldock is simply adjusted by hand to move eye tissue in predetermined amounts so that a lens can be inserted, rather than a spacer which responds in real time to flexion and extension positions of the knee. Waldock is an entirely different application of a tool for eye surgery than in the present application of knee arthroplasty.

(2) The movable members (10, 12) of Waldock are not “planar members” as required by claim 1, nor is there any reason for them to be planar. In fact, if the Waldock members were planar, the Waldock device would not function in the manner in which it is intended. The first and second members of the present invention are planar in shape, because they must reside entirely within the knee space during surgery.

(3) Unlike the Waldock device, the present invention requires that the “tissue engaging surfaces” are effectively stacked on top of the “tensioning surfaces”. In Waldock, the tissue engaging surfaces are at the far end of the device, while the adjusting mechanism and all of the measurement information is on the opposite end. In fact, Waldock is similar to the previously cited Tuke reference (US 5,800,438) which has its adjustment mechanism (or “tensioning means”) located away from the operative end that contacts the tissue. That is precisely what the present invention is trying to overcome. In order to further clarify and distinguish the present invention over Waldock, claim 1 has been amended to require that the tensioning means resides entirely between the upper and lower tissue engaging surfaces.

Furthermore, Waldock could never solve the problem addressed by the present invention, because the location of the patella (knee cap) makes measurement using external tools very difficult, if not impossible. It is also impossible for a device like Waldock to measure through a continuous range of motion of the knee from flexion to extension, as is

permitted by the applicant's dynamic spacer. Thus, Waldock's design differs substantially from the present invention, both structurally and functionally, and Waldock fails to disclose the required elements of claim 1. Claim 2 adds further limitations to the invention in the form of means for measuring the necessary distances. Therefore, it is respectfully requested that the rejections of claims 1 and 2 under §102(b) be withdrawn.

### III. Rejections Based on 35 U.S.C. § 103(a)

Claims 5 and 7-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Waldock in view of other prior art. Those rejections are respectfully traversed.

For the reasons expressed above with respect to the rejections under §102(b), the Waldock reference lacks various features and elements which are required by amended claim 1. Waldock is also insufficient to support a prima facie rejection based on obviousness. As explained above, Waldock is incapable of accomplishing the intended function of the present invention, because it simply provides an indication of the distance between the tips for the purpose of a lens insertion. Waldock cannot be readily modified (and still perform its function) to accomplish the same result as the present invention. Furthermore, Waldock should not be regarded as analogous art, because a person of ordinary skill in the field of arthroplasty would never look to the field of ophthalmic surgery for a solution to the problems stated in the present application.

Because the other cited references fail to disclose the features of claims 5 and 7-11 which Waldock lacks, those combinations are incomplete and insufficient to support a prima facie obviousness rejection. For these reasons, claims 5 and 7-11 are both novel and nonobvious over the cited combinations, and it is respectfully requested that the rejection of those claims under §103(a) be withdrawn.

IV. Conclusion; Request for Telephone Interview

For the reasons expressed herein, the applicant respectfully requests that a Notice of Allowance be issued in this case. If the Office believes that there remain any impediments to such a Notice of Allowance, the undersigned expressly requests that a telephone interview be scheduled and conducted before the Office takes further action on this application. The Office's accommodation of this interview request is greatly appreciated.

Respectfully submitted:

**BAKER, DONELSON, BEARMAN,  
CALDWELL & BERKOWITZ, PC**

/Warner J. Delaune/

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Warner J. Delaune, Jr., REG. NO. 36,781  
301 N. Main Street, Suite 810  
Baton Rouge, Louisiana 70825  
TEL: (225) 381-7032  
FAX: (225) 343-3612  
E-MAIL: [wde-laune@bakerdonelson.com](mailto:wde-laune@bakerdonelson.com)